REMARKS

Claims 1-20 are pending in this application. All claims stand rejected. Independent claims 1 and 18 have been amended.

The foregoing amendments and following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

Independent claims 1 and 16 have been amended to more clearly point out that the dormancy feature can be enabled or disabled. The amendment does not raise any new issues because it does not change the meaning of the claims. The amendment is presented only because the Examiner commented that the claims did not recite that that a dormancy feature allows one or more of the plurality of items and its associated parameter to be placed in a dormant state. This is no different than saying that the dormancy feature can be enabled or disabled, which was previously in the claims.

Since the rejection was based on the misreading of the claims, reconsideration of Applicant's arguments reproduced below in view of the present clarification amendment is respectfully solicited.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 11-14, and 16-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Smith ('072) reference in view of the Haines ('423) reference.

Claims 1, 2, 11-14, and 16-19 are rejected under 35 U.S.C 103(a) as being unpatentable over Smith (2003/0172072) further in view of Haines (6,295,423). Claims 3-6 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (2003/0172072) in view of Haines (6,295,423) and further in view of Martin et al. (5,809,479). Claims 9, 10, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (2003/0172072) in view of Haines (6,295,423) and further in view of Aoyama et al. (2004/0172341).

The Examiner admits that Smith "fails to disclose...[a] computational element [that] provides a dormancy feature...." The Examiner continues by suggesting that it would have been obvious to combine the threshold-defining mechanism of Haines. However, the Examiner does not suggest that Haines includes a dormancy feature that would allow an item and its associated parameter

to be placed in a dormant state so that the parameter associated with the dormant item does not become a trigger point for the tracking device to generate an order for the dormant items.

The Examiner has responded to Applicants' arguments following to the Final Rejection of April 1, 2008, by pointing out that Applicants' preferred embodiment uses page count and parameters related to customer usage to create an ORC [operator replicable component] tracking table. The Examiner is correct. The Examiner concludes that the parameter is therefore set by the customer's usage. This is not exactly true (the parameter measures customer usage, but is not set by customer usage), but this detail is not really relevant to the issue at hand anyway, as will be seen immediately below. Finally, the Examiner correctly points out that Applicants define the term "dormancy" as referring to whether a parameter for an ORC device is to be used as a trigger point to alert the operator to a potential problem with that ORC device. The Examiner ignores the next sentence of the disclosure, and this is a very important sentence. It reads: **"The dormancy feature can be either enabled or disabled."** Thus, as disclosed by Applicants and admitted by the Examiner, the dormancy feature of the present invention allows disabling the ORC device so that there will be no operator alert generated even once the expected life of the ORC device has expired.

The Examiner notes that the predicted lifetime threshold of Haines can be user-defined, and suggests that that this fact results in the monitor being dormant until the threshold is reached. However, the fact that the threshold has not yet been reached does not imply that the monitor that measures the parameter has gone "dormant" as that term is defined in the present application. The Haines monitor remains active so that an alert is generated once the adjustable threshold is reached. There is no teaching in Haines that the monitoring system goes dormant so that the monitored parameter is not to be used as a trigger point even once the threshold is reached.

Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. The Smith fails to disclose a dormancy feature that would allow an item and its associated parameter to be placed in a dormant state so that the parameter associated with the dormant item does not become a trigger point for the tracking device to generate an order for the dormant

items. Haines fails to disclose the information undisclosed by Smith. To establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. *See* MPEP 2143.03. It is well established in the law that, for a proper prima facie rejection of a claimed invention on the basis of obviousness under 35 U.S.C. 103, the references relied upon must teach every element of the claimed invention. "Each element of a claim is material." *Ashland Oil*, Inc. v. *Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985).

CONCLUSION

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.